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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,404	12/01/2000	Satoshi Nishikawa	862.C2066	1364

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EXAMINER

QIN, YIXING

ART UNIT PAPER NUMBER

2622

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/726,404

Applicant(s)

NISHIKAWA, SATOSHI

Examiner

Yixing Qin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6-11 and 27-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-11 and 27-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 December 2000 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

In response to applicant's amendment received 2/18/05, all requested changes have been entered. New claims 27-41 have been added.

### ***Response to Arguments***

The indicated allowability of claims 6-11 is withdrawn in view of Shima et al (U.S. Patent No. 6,104,498). Rejections based on the newly cited reference(s) follow. Claims 6-11 are rejected under previously cited references Shima et al and Williams et al.

### ***Claim Rejections - 35 USC § 112***

Claims 6, 27, 32, and 37 recites the limitation "...the designated number of sets of copies..." in the first limitation of each of these claims. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

I. Claims 6-9, 11, 27-30, 32-35, and 37-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shima et al (U.S. Patent No. 6,104,498).

**1. Claims 6, 27, 32, and 37**

- Shima et al discloses in column 2, lines 32-38 discloses that a computer (i.e. **print control apparatus**) can send M copies of pages to a printer. This is essentially a queue of pages that gets sent to the printer. This is analogous to a spooler, which is basically a queue storage mechanism. Please also note Yoneda (US Patent No. 6,147,765 - Fig. 9, column 4, lines 21-22) and Fall et al (US Patent No. 5,764,863 - column 2, lines 22-25) for further support that copies and data can be saved to a spooler.
- Shima discloses in Fig. 14 and column 14, lines 18-29 the flow that takes place for performing a test print. Fig. 12, item S59 discloses the checking of a test print. Although Shima does not call the program that executes this flow a "spool file manager," the spool file manager is that is being claimed is only a program that performs certain functions, which are disclosed by the Shima reference as noted above.
- The data is not explicitly disclosed to be taken from the spooler for printing, but the use of spoolers and queues to send data to a printer is well-known feature and would be obvious for one of ordinary skill in the art to print data that is sent from a spooler or a queue.

**2. Claims 7, 28, 33, and 38**

- Shima et al discloses in fig. 9 and column 10, lines 1-3, that "If the number of copies is reached, all information read from the storage means and printed is deleted from the storage means at step S39." This claim is analyzed in a similar fashion as the previously rejected, and currently canceled, claim 2.

**3. Claims 8, 29, 34 and 39**

- Shima et al discloses in fig. 13 and column 14, lines 13-15, that "If the test print is OK, print of the second page to the Pth page is executed at steps S74-S77. Next, the remaining (M-1) copies are printed at steps S78-S83." The M that Shima et al refers to a register that keeps track of the number of copies the job has. The point is that Shima et al is reducing the number of copies left to print since the test copy can simply be used as one of the copies that is needed.

**4. Claims 9, 30, 35, and 40**

- Shima et al discloses in column 3, lines 28-5 that "...format conversion means for converting a format of the print information to prepare intermediate print information, means for storing the data and the intermediate print information..." and "...the storage means consists of a RAM and auxiliary storage means ..." In regards to the "...change step of changing the setup associated...", Shima et al discloses in column 3, lines 18-23, that their invention "...enables[s] print specifications to be changed even after print information is transmitted..." The idea behind Shima et al's statement is that there is no need to retransmit information; it can simply be changed "on the fly."

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**5. Claim 11**

- Shima discloses in column 1, lines 11-13 that a host computer can output data to a printer.

II. Claims 10, 31, 36 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shima et al (U.S. Patent No. 6,104,498) in view of Williams et al (U.S. Patent No. 5,237,923).

**6. Claims 10, 31, 36 and 41**

- the Shima et al reference discloses all the limitations of claim 5 except for "...the step of resetting the designated number of sets of copies..." The secondary reference by Williams et al teaches in column 8, lines 61-68 and column 9 line 3, the printing of "proof copies of the original document, the number being determined by the operator's instructions entered via keyboard..." and when "...acceptable, the operator can instruct the press to print the required number of final copies." Also, Williams et al takes into account that "[i]f changes are required, new printing plates can be made..." The point here is that Williams et al's reference accounts for changes in "proof" (test) copies and the ability to change the number of copies to any value based on user input. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include a step of resetting the number of copies to a designated value when test printing is involved as taught by the Williams et al reference in light of the Shima et al invention. The motivation is to be able to print the appropriate number of copies if the test print is deemed to be acceptable.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yixing Qin whose telephone number is (571)272-7381.


The examiner can normally be reached on M-F 9:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571)272-7402. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YQ

  
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SUPERVISORY PATENT EXAMINER  
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